

## **REMARKS**

Claims 1-39 were pending in the application. The Office Action dated February 28, 2008 rejects claims 1-39. The Office Action also objects to the Specification as failing to provide proper antecedent basis for the claimed subject matter. This paper amends claims 1-4, 7, 8, and 10, and cancels claims 12-39. Notwithstanding the cancellation of claims 12-39, applicant does not concede the validity of their rejection, and expressly reserves the right to pursue these claims and other claims in a continuation and/or divisional patent applications. Claims 1-11 are now pending in the application.

Applicant's undersigned representative thanks Examiner Blair for his time and courtesy during the telephonic interview of March 25, 2008. During the interview, they discussed the primary reference, Gross, with respect to the applicant's invention as set forth in proposed amended claim 1. Agreement was reached that the proposed amendment, as now set forth in applicant's independent claim 1, appears to overcome the Gross reference. Further, it was discussed and agreed that amending the "a second email message" language in claim 1 to read "a particular email message" appears to overcome the § 112 rejection (provided there is a corresponding amendment to claim 2 to reestablish antecedent basis).

### **Claim Rejections – 35 U.S.C. § 101**

The Office Action rejects claims 26-39 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. In view of the cancellation of these claims, applicant submits that the rejections are moot.

### **Claim Rejections – 35 U.S.C. 112**

The Office Action rejects claims 2, 13, 20, 27, and 34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out

and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Office Action considers the language of claim 2 to contradict the language of claim 1 from which claim 2 depends. Applicant respectfully submits that its amendments to claims 1 and 2 eliminate the perceived contradiction and overcomes the rejection.

**Claim Rejections – 35 U.S.C. 102**

The Office Action rejects claims 1-7,12-16, 19-23, 26-30, and 33-37 under 35 U.S.C. § 102(b) as being anticipated by Gross (U.S. Patent No. 5,555,346). Applicant respectfully traverses the rejection to the extent it is maintained against the claims as now amended.

Applicant's invention, as now sent forth in independent claim 1, features a method of managing electronic mail (email) messages in an email account. While a first open email message is being displayed to the user, an intent of the user to perform an action that results in closing the first open email message is detected. In response to detecting this intent, a plurality of deletion options is presented to the user from which the user selects one deletion option before the action can be completed. In automatic response to receiving the user's selection, the action is completed for the first email message and a deletion criterion is set for a particular email message based on the selected deletion option.

Gross teaches a rule-based email handler that operates on an email folder, such as "inbox". Granted, FIG. 10F of Gross shows that a plurality of deletion options may be presented to the user. However, these deletion options pertain to an entire email folder. Unlike the applicant's claimed invention, they are not presented to the user (1) while an open email message is displayed to the user and (2) in automatic response to detecting intent to perform an action that results in closing the email message. Moreover, Gross does not teach or

suggest that the action that results in closing the email message is completed in automatic response to receiving the user's selection of a deletion option. Therefore, Gross not only does not anticipate the Applicants' invention, but also cannot be seen to suggest it. Thus, Applicants respectfully request this rejection be withdrawn.

Each pending dependent claim depends directly or indirectly from one of the patentable independent claims and incorporates all of its respective limitations and, therefore, is patentable for at least this reason. Moreover, each dependent claim also recites an additional limitation, which, in combination with the elements and limitations of its independent claim, can further distinguish that dependent claim from the cited reference.

**Claim Rejections – 35 U.S.C. 103**

The Office Action rejects claims 8, 10-11, 17-18, 24-25, 31-32, and 38-39 under 35 U.S.C. 103(a) as being unpatentable over Gross in view of Rousse et al. (U.S. Publication No. 2002/0090933). Applicant respectfully traverses this rejection because Gross and Rousse, whether taken alone or in combination, neither teach nor suggest presenting a plurality of deletion options to the user in automatic response to detecting the user's intent to perform an action that results in closing an open email message, as now set forth in the applicant's claimed invention.

Moreover, each of the dependent claims depends directly or indirectly from patentable independent claim 1, and incorporates all of its limitations and, therefore, is patentably distinguishable over the cited references for at least this reason. Applicant respectfully submits that the amendment overcomes the rejection and, therefore, requests that the rejection be withdrawn.

**CONCLUSION**

Applicant submits that this paper provides a response for all pending claims. Any absence of a reply to a specific rejection, issue, or comment, or to any taking of "official notice" or reliance on "common sense", however, does not signify agreement with or concession of that rejection, issue, comment, taking of "official notice", or reliance on "common sense". In addition, because the arguments made above are not exhaustive, there may be reasons for patentability of any or all pending claims that have not been expressed.

In view of the amendments and arguments provided herein, applicant submits that the application is in condition for allowance and requests early favorable action by the Examiner.

If the Examiner believes that a telephone conversation with the applicant's representative would expedite allowance of this application, the Examiner is cordially invited to call the undersigned at (508) 303-0932.

Respectfully submitted,

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